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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,278	03/15/2001	Robert Skvorecz	4336	9274

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Eugene Lieberstein  
Anderson Kill & Olick  
1251 Avenue of the Americas  
New York, NY 10020-1182

[REDACTED] EXAMINER

LE, TAN

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3632

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. <b>09/772,278</b>	Applicant(s) <b>Skvorecz</b>
	Examiner <b>Tan Le</b>	Art Unit <b>3632</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on Apr 18, 2002
  - 2a)  This action is **FINAL**.      2b)  This action is non-final.
  - 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- Disposition of Claims**
- 4)  Claim(s) 1-7 is/are pending in the application.
  - 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5)  Claim(s) 6 is/are allowed.
  - 6)  Claim(s) 1-5 and 7 is/are rejected.
  - 7)  Claim(s) \_\_\_\_\_ is/are objected to.
  - 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This is the second office action for application serial number 09/772,278, Wire Chaffing Stand, filed on 03/15/01.
2. This application is a reissue of application 09/005,787 filed January 12, 1998 now as Patent No. 5,996,948 which issued on December 07, 1999. This reissue application contains 7 claims numbered 1-7. New claim 7 has been added which recites the limitations omitted from claim 1.
3. Applicant's paragraph two of the response regarding a supplemental Reissue Oath/Declaration under 37 CFR 1.175(b)(1) and new claim 7 which will be fully underlined has been noted. However, the rejection under 251 still stands until Applicant submitted a supplemental reissue Oath/Declaration.
4. Claims 1-5 and 7 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the reissue declaration is set forth in the discussion above in this Office action.

#### ***Recapture***

5. Claims 1-5 and 7 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d

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1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

In the present reissue application, Applicants seek to delete from patent claim 1 the language underlined below to enlarge the scope of claim 1 of the patent, and to include it in a new dependent claim 7. The deletion of "a lower rim of wire steel forming a closed geometrical configuration circumscribing a second surface area with said first surface area being larger than said second surface area" (lines 5-10); the deletion of "at a location below the lower rim" (lines 14-15); and the deletion of "and to said lower rim at a relatively equal distance below the point of attachment to said upper rim" (lines 24-27) thus broaden the scope of the reissue claim 1 as a result of the deletion of the above limitations.

The issue of "*recapture*" as set forth in MPEP 1412.02 does appear to be at issue in the instant reissue application. The examiner has reviewed the patent file as to the changes made in the claims. An amendment was filed on July 26, 1999 after a first rejection. The amendment filed on July 26, 1999 (Paper No. 3 in the patented file) made changes to the independent claim 1 which involved changing "a pair of wire legs of equal length affixed at one end thereof to the upper rim and affixed to the lower rim at an equal location substantially approximate the opposite end of each wire leg such that the upper rim and lower rim lie in substantial parallel alignment to one another with the wire legs extending equal distances below the lower rim to uniformly support the stand at opposing ends thereof and having a plurality of offsets in the upper rim of said stand or in the wire legs at the point of interconnection therebetween" to --a plurality of wire

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legs with each wire leg having two upright sections interconnected to one another *at a location below the lower rim* in a configuration forming a base support for the stand to rest upon with each upright section extending upwardly from said base support to form an angle equal to or greater than 90 degrees with respect to a horizontal plane through said base support and being affixed to the upper rim adjacent one end thereof *and to said lower rim at a relatively equal distance below the point of attachment to said upper rim* and further comprising a plurality of offsets located either in said upright sections of said wire legs or in said upper rim for laterally displacing each wire leg relative to said upper rim to facilitate the nesting of a multiplicity of stands into one another without significant wedging--. Changes to claim 1 were made by Applicant in an effort to overcome the prior art rejection, especially the limitations (which were omitted in the reissue, as highlighted above) were in fact added in the original application claim 1 to overcome the prior art rejection to make the claims allowable.

Applicants in the reissue claim has now attempted to modify those changes by deleting one of those limitations in the reissue claim 1 providing a broadening aspect relates to surrendered subject matter that Applicant previously surrendered—that is a recapture of subject matter that Applicant has given up. In addition to the changes above, Applicant also made an statement on the record that "Additionally, claim 1 requires each wire leg to have two upright sections which are interconnected to one another *at a location below the lower rim* in a configuration forming a base support for the stand to rest upon" (see page 4, lines 11-13 of the amendment filed on July 26, 1999 ). This statement is also sufficient to establish surrender and recapture.

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Applicants asserting in the paragraph 4 of the new reissue declaration that “the error upon which this reissue is based relates to the inclusion in claim 1 and 3 of an unnecessary limitation which restricted the claims to a wire chafing stand having both an upper and lower rim and to the use of the term “plurality” before “wire legs” which may be improperly construed to represent “four” wire legs corresponding to the number shown in the drawings”, thus the Applicant seeks to enlarge the scope of the claim 1 of the patent, and was properly filed within two years from the grant of the patent, as provided by the fourth paragraph of 35 U.S.C 251. However, based on the review of the patent file, the examiner considers the narrow scope of the claim 1 in the patent file was not an error within the meaning of 35 U.S.C 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The examiner also disagrees with Applicant’s statement in the paragraph 9 of the reissue declaration that the patentability was based upon the requirement as written. The patentability was based upon a plurality of wire legs with each wire leg having two upright sections interconnected to one another *at a location below the lower rim*... with each upright stand section from the base support to form an angle equal or greater than 90 degrees... and being affixed to the upper rim adjacent one end thereof *and to the lower rim at a relatively equal distance below the point of attachment to the upper rim*... (see notice of allowance of August 12, 1999, Paper No. 5). The omitted limitations as highlighted above were in fact part of the examiner’s reasons for allowance in the original application.

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***Response to Arguments***

6. Applicant contended that examiner's comparison of the language in the issued claim and the underlying of selected words in claim 1 gives misplaced emphasis to words which were never involved in the prosecution and have no relevance to the allowance". Applicant further contended that "the lower rim is not related to the invention and was acknowledged as being known in the prior art..." and "Applicant at no time argued that the lower rim was novel or was not shown in Andrews...", and on the last page of the response, Applicant further added that "examiner is now reading and comparing the claims in a vacuum independent of the file history...this is not a test for recapture as set forth in chapter XIV of the MPEP".

First, examiner respectfully submits that the record of the original application shows that the broadening aspect (in the reissue) relates to subject matter that Applicant previously surrendered during the prosecution of the application as pointed out in the above rejection. Pursuant to the guidelines on page 4 of the Memorandum of the Patent Office about Recapture Rule to Reissue Application dated September 21, 1999, the narrow scope of the claim 1 in the reissue parent patent is not an error within the meaning of 35 U.S.C. 251. Therefore, the broader scope surrendered in the reissue parent application cannot be recaptured by the filing of the present reissue application. This rule has been recently reiterated by the Court in *Pannu v. Storz Instruments Inc.*, 59 U.S.P.Q. 2d 1597 (CAFC 7/25/01).

It is also well settled that a reissue application is not permitted to "recapture" claimed subject matter deliberately canceled in the original application. *In re Clement*, 45 U.S.P.Q. 1161

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(CAFC 1997). See M.P.E.P. 1412.02. Note also that in *Hester v. Stein, Inc.*, 46 U.S.P.Q.2d 1641 (CAFC 1998), the Court held that the recapture rule can be triggered by argument alone. Applicant *cannot* acquire, through reissue, claims that are the *same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection*. In this case, the art rejection in the reissued parent patent application was Andrews (Claim 1 was rejected under 35 USC 102 as being anticipated by U.S. Patent No. 1,688,846 to Andrews). The test is not whether Applicant “never argued the lower rim was novel or was not shown in Andrews”. The test is *whether the claim 1 of the reissue application is the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection*” as mentioned above.

Second, examiner respectfully submits that if the statement “the lower rim is not related to the invention and was acknowledged as being known in the prior art” is true, then at the time Applicant received the notice of allowance, Applicant should have filed a correction to correct “the lower rim” should not be in the allowance statement when received from the examiner. The above statement is also contrary to what Applicant has been described in the the reissue parent application and argued during prosecution of parent case (Applicant made a statement on the record that “Additionally, claim 1 *requires* each wire leg to have two upright sections which are interconnected to one another at a location below the lower rim in a configuration forming a base support for the stand to rest upon” (see page 4, lines 11-13 of the amendment filed on July

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26, 1999)). Further, it is also contrary to what Applicant has been claimed in new claim 7 of the reissue application.

For the reasons set forth above, the rejection based on recapture rule is maintained.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tan Le, whose telephone number is 703.305.8244. The Examiner can normally be reached on Monday through Thursday, 9:00-6:00 and alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for official communications and (703) 872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this Application should be directed to the Group receptionist at 703.308.2168.

Tan Le  
Patent Examiner  
AU 3632  
December 12, 2002.



ANITA KING  
PRIMARY EXAMINER